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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,442	03/12/2004	Rainer Muller	5725.0864-01	5278

22852 7590 06/09/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,442	MULLER ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-23 and 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Receipt is acknowledged of amendment filed on 6/3/05. Claims 14-18, 24-30 have been canceled and claim 38 has been added as per applicant's amendment dated 6/3/05. Claims 19-23, and 31-38 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 19-23, and 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,143,286 ('286) and 5,523,017 ('017).

Art Unit: 1615

The instant application is claiming a detergent and conditioning cosmetic hair composition comprising:

- 1. A washing base (surfactant)*
- 2. Liquid esters of formula I (species are claimed in claims 22-23)*
- 3. Adjuvant (cationic polymers of claims 34-35)*

Patent '286 teaches compositions for hair using 1-3. See col.16, line 10 for the range of the detergent base which is same as surfactant, see col.16, lines 15 et seq, col.16, and col.17, lines 1-27. See col.14, lines 29-30 for the range, which overlaps with the claimed liquid ester range, see col.14, lines 42 and 43 for the two species which are " isostearyl neopentanoate and tridecyl neopentanoate" which reads on the claimed liquid esters. These species reads on the claimed esters wherein R1 is tertiary butyl group and R2 is tridecyl or isostearyl group. See col.2, lines 61-63 for the range of claimed adjuvant, which is also the claimed cationic polymers and see col.4, lines 34-35 for the claimed quaternary cellulose ether derivatives. See col.16, lines 13 for claimed adjuvants, which are silicones and vitamins. The patent teaches various oils as conditioning agents. Patent '017 teaches solid cleansing bar using the ingredients 1-3 and not the cationic polymers. See examples 2-3 where the patent teaches the surfactant, which are lauryl ether sulfate, betaines and amides. The patent at col.2, lines 17-22 clearly teach to one of ordinary skill in the art that the composition includes coactive ingredients and the patent teaches emollients. See col.6, line 49 where the patent names 2 compounds. One of the compounds is isostearyl neopentanoate. This is the claimed species wherein R1 is tertiary butyl group and R2 is tridecyl or isostearyl group. See also col.5, lines 40-65.

Art Unit: 1615

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '286 and combine it with the emollient taught by '017 expecting beneficial effect. One of ordinary skill in the art would be motivated to combine the isostearyl neopentanoate into the compositions of example 1 of the patent '286 with the reasonable expectation of success that the compositions provide excellent cleansing properties and the emollient provides conditioning effects to the hair. Absent a showing side by side comparison of example 1 of '286 vs. example 4 of '017 vs. instant application exhibiting unexpected and superior results commensurate with the scope of claims, the claims are rendered prima facie obvious over the combination of the patents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/798,442

Page 5

Art Unit: 1615

A handwritten signature in black ink, appearing to read "J. Venkat".

JYOTHSNA A VENKAT Ph. D

Primary Examiner

Art Unit 1615
